

ESTTA Tracking number: **ESTTA372573**

Filing date: **10/11/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	LFP IP, LLC
Granted to Date of previous extension	10/09/2010
Address	8484 Wilshire Boulevard, Suite 900 Beverly Hills, CA 90211 UNITED STATES
Correspondence information	Jonathan W. Brown Attorney of Record, New York Bar Member Lipsitz Green Scime Cambria LLP 42 Delaware Avenue Suite 120 Buffalo, NY 14202 UNITED STATES ip@lglaw.com Phone:716-849-1333 Ext. 371

Applicant Information

Application No	77962645	Publication date	08/10/2010
Opposition Filing Date	10/11/2010	Opposition Period Ends	10/09/2010
Applicant	The Heart Of A Hustler Productions 500 Clinton Avenue Newark, NJ 07108 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films


Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1474758	Application Date	10/25/1984
Registration Date	02/02/1988	Foreign Priority	NONE


		Date	
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1983/11/01 First Use In Commerce: 1983/11/01 PRE-RECORDED VIDEO TAPES		

U.S. Registration No.	2677772	Application Date	04/08/2002
Registration Date	01/21/2003	Foreign Priority Date	NONE
Word Mark	HUSTLER VIDEO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/09/14 First Use In Commerce: 1999/09/14 pre-recorded videotapes and digital video discs (DVDs) in the field of adult entertainment		


U.S. Registration No.	3431048	Application Date	10/26/2007
Registration Date	05/20/2008	Foreign Priority Date	NONE
Word Mark	HUSTLER VIDEO		
Design Mark			
Description of Mark	The mark consists of a rectangle with a black background. At the top of the rectangle is "HUSTLER" in white block letters; at the bottom is "VIDEO" in block letters. Inside the black rectangle is a pink rectangle bordered with a narrow band of white and rounded edges. There is a figure of a female silhouette in white, and a narrow band of white forming a large circle across the pink rectangle.		
Goods/Services	Class 009. First use: First Use: 2006/12/15 First Use In Commerce: 2006/12/15		

	Digital materials, namely, digital video discs (DVDs), downloadable films provided via a video-on demand service, and downloadable video files, all featuring adult entertainment
--	---

U.S. Registration No.	3008879	Application Date	09/01/2004
Registration Date	10/25/2005	Foreign Priority Date	NONE
Word Mark	HUSTLER TV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/08/24 First Use In Commerce: 2004/08/24 Pre-recorded video tapes and DVDs in the field of adult entertainment		

U.S. Registration No.	3008950	Application Date	09/17/2004
Registration Date	10/25/2005	Foreign Priority Date	NONE
Word Mark	HUSTLER TV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2004/04/20 First Use In Commerce: 2004/04/20 Cable, satellite, television and video-on-demand (VOD) broadcasting		

U.S. Registration No.	3719932	Application Date	02/11/2009
Registration Date	12/01/2009	Foreign Priority Date	NONE
Word Mark	HUSTLER HD		

Design Mark	
Description of Mark	The color black appears in the word "HUSTLER" and in the rectangular background behind the acronym "HD"; the color gray appears in the outline around each letter in the word "HUSTLER" and the outline around the outside of the rectangular background behind the acronym "HD"; the color blue appears in the letters "HD"; and the color white appears in the rectangular background of the entire mark.
Goods/Services	Class 038. First use: First Use: 2009/06/13 First Use In Commerce: 2009/06/13 Broadcasting services and provision of telecommunication access to films and television programmes provided via a video-on-demand service

Attachments	76393623#TMSN.gif (1 page)(bytes) 77314657#TMSN.jpeg (1 page)(bytes) 78477307#TMSN.jpeg (1 page)(bytes) 78485451#TMSN.jpeg (1 page)(bytes) 77668581#TMSN.jpeg (1 page)(bytes) int4B.PDF (6 pages)(206290 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan W. Brown/
Name	Jonathan W. Brown
Date	10/11/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 77962645

Filed: March 18, 2010

Published: August 10, 2010 in the Official Gazette

For: **HEART OF A HUSTLER \$ \$**

LFP IP, LLC,

Opposer,

vs.

THE HEART OF A HUSTLER PRODUCTIONS, LLC

Applicant.

**NOTICE OF
OPPOSITION**

Opposition No. _____

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

LFP IP, LLC (“LFP”), a Delaware limited liability company, located and doing business at 8484 Wilshire Boulevard, Suite 900, Beverly Hills, California 90211, believes that it will be damaged by the registration on the principal register of the mark “**HEART OF A HUSTLER \$ \$**” shown in Application Serial No. 77962645. Said Application was filed by The Heart of a Hustler Productions, LLC (“Applicant”), upon information and belief, a limited liability company with a mailing address of 500 Clinton Avenue, Newark, New Jersey 07108, and published for opposition in the Official Gazette; LFP hereby opposes registration thereof.

As grounds for opposition, LFP alleges:

1. LFP is the owner of numerous HUSTLER trademark registrations, including, but not limited to, trademarks for goods and services connected and/or relating to video and film.

2. LFP is the owner of Registration No. 1474758 for **HUSTLER** for “pre-recorded video tapes.” LFP’s application for said registration was filed on October 25, 1984, and progressed to registration on February 2, 1988, and is now deemed incontestable. LFP has used the mark **HUSTLER** on and in connection with the sale of the aforementioned goods since at least as early as November 1, 1983.

3. LFP is also the owner of Registration No. 2677772 for **HUSTLER VIDEO** for “pre-recorded videotapes and digital video discs (DVDs) in the field of adult entertainment.” LFP’s application for said registration was filed on April 8, 2002, and progressed to registration on January 21, 2003. LFP has used the mark **HUSTLER VIDEO** on and in connection with the sale of the aforementioned goods since at least as early as September 14, 1999.

4. LFP is also the owner of Registration No. 3431048 for design mark **HUSTLER VIDEO** for “digital materials, namely, digital video discs (DVDs), downloadable films provided via a video-on-demand service, and downloadable video files, all featuring adult entertainment.” LFP application for said registration was filed on October 26, 2007, and progressed to registration on May 20, 2008. LFP has used the design mark **HUSTLER VIDEO** on and in connection with the sale of the aforementioned goods since at least as early as December 15, 2006.

5. LFP is also the owner of Registration No. 3008879 for **HUSTLER TV** for “pre-recorded video tapes and DVDs in the field of adult entertainment.” LFP’s application for said registration was filed on September 1, 2004, and progressed to registration on October 25, 2005.

LFP has used the mark **HUSTLER TV** on and in connection with the aforementioned services since as early as August 24, 2004.

6. LFP is also the owner of Registration No. 3008950 for **HUSTLER TV** for “cable, satellite, television and video-on-demand (VOD) broadcasting.” LFP’s application for said registration was filed on September 17, 2004, and progressed to registration on October 25, 2005. LFP has used the mark **HUSTLER TV** on and in connection with the aforementioned services since as early as April 20, 2004.

7. LFP is also the owner of Registration No. 3719932 for **HUSTLER HD** for “broadcasting services and provision of telecommunication access to films and television programmes provided via a video-on-demand service.” LFP’s application for said registration was filed on February 11, 2009, and progressed to registration on December 1, 2009. LFP has used the mark **HUSTLER HD** on and in connection with the aforementioned services since as early as June 13, 2009.

8. LFP’s marks referred to hereinabove will be collectively referred to as “LFP’s Marks.”

9. As a result of LFP’s extensive advertising, sales, and marketing of goods bearing LFP’s Marks, said Marks have become famous and well-known to purchasers.

10. By virtue of LFP’s extensive use and promotion of LFP’s Marks, LFP has established valuable goodwill in the marks, and the public has come to associate LFP’s Marks with LFP and its famous founder, Larry Flynt. As such, the public has come to know LFP’s Marks as an indication of goods and services that originate from LFP or “Larry Flynt Publications,” and their affiliated companies.

11. On March 18, 2010, Applicant filed U.S. Trademark Application Serial No. 77962645, based on its intent to use the mark “**HEART OF A HUSTLER \$ \$**” in connection with “multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films.” Applicant’s mark referred to hereinabove will be referred to collectively as “Applicant’s Mark” or the “Application.”

12. The goods and/or services identified in the Application are highly related to the goods and/or services identified in LFP’s registrations and applications for its **HUSTLER** mark, and with which LFP has been using its various **HUSTLER** marks for many years.

13. Applicant’s proposed “**HEART OF A HUSTLER \$ \$**” Mark includes LFP’s entire **HUSTLER** mark.

14. On information and belief, Applicant selected the **HUSTLER** portion of its mark as a direct reference to LFP’s **HUSTLER** mark, which was intended to profit from LFP’s name and goodwill by creating a misleading association of Applicant’s mark and Applicant’s goods with LFP, and thereby blurring and tarnishing LFP’s valuable Marks.

15. LFP began use of its **HUSTLER** mark in connection with videos and films as early as 1983, which is well prior to Applicant’s March 18, 2010 filing date of the Application.

16. As a result of the similarity between LFP’s Marks and Applicant’s mark and the highly related nature of the goods and services identified by the parties’ marks, Applicant’s mark is likely to cause confusion, mistake or deception in the trade and among ordinary purchasers as to the source, origin or sponsorship of the parties’ respective goods and services.

17. Registration of the mark in the Application and use of Applicant’s mark is likely to dilute and tarnish LFP’s famous **HUSTLER** marks.

18. Registration of Applicant's mark will result in damage to LFP under the provisions of 15 U.S.C. §§ 1114, 1115 and 1125, pursuant to the allegations stated above, and registration should be denied pursuant to 15 U.S.C. § 1052(d).

19. If the Applicant's mark is permitted to obtain registration, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the "**HEART OF A HUSTLER \$ \$**" mark. Such registration would cause confusion among consumers as to the separate and distinct sources of Applicant's goods and services and LFP's goods and services and the relationship of LFP to Applicant, thereby damaging LFP's goodwill in LFP's Marks, diluting the value thereof, and resulting in irreparable harm to LFP's business and reputation, all to the detriment of LFP which has expended considerable sums and effort in promoting its various HUSTLER trademarks.

WHEREFORE, LFP prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 77962645 be denied.

Dated: October 11, 2010

Respectfully submitted,

LFP IP, LLC by its counsel
Lipsitz Green Scime Cambria LLC

By: /Jonathan W. Brown/
Jonathan W. Brown, Esq.
42 Delaware Avenue, Suite 120
Buffalo, NY 14202
(716) 849-1333 Ext. 371

CERTIFICATE OF FILING AND SERVICE

I, Jonathan W. Brown, hereby certify that on October 11, 2010, I caused a true copy of the foregoing Notice of Opposition to be filed electronically with the United States Patent and Trademark Office and served upon Applicant, The Heart Of A Hustler Productions, by United States First Class Mail addressed to 500 Clinton Avenue, Newark, New Jersey 07108.

Dated: October 11, 2010

/Jonathan W. Brown/

1228299-v1
11740.0183